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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,930	11/20/2003	Darrell H. Carney	3033.1005-003	3456

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EXAMINER

UNGAR, SUSAN NMN

ART UNIT PAPER NUMBER

1642

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/718,930

Applicant(s)

CARNEY ET AL.

Examiner

Susan Ungar

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-8 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. Claims 1-8 are pending in the application and are currently under prosecution.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Groups 1-4.** Claims 1-2 are drawn to four inventions, each of which is a polypeptide, each of which is a distinct invention for the reasons set forth below, classified as Class 530, subclass 300+. It is noted for Applicant's convenience that this is a requirement for the election of a Group for examination NOT a requirement for an election of species because although the claims are presented in Markush format, the claims are drawn to methods using multiple agents which do not share, as a whole, a substantial structural feature disclosed as being essential to their utility. Thus, the analysis of the claims, for restriction purposes, is subject to the findings of the court wherein the court found that unity of invention exists where entities included within a Markush group share a substantial structural feature disclosed as being essential to utility of the Markush group, *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Since the members of the group do not share a substantial structural feature disclosed as being essential to utility of the Markush group, the group as claimed fails the Harnisch test and the claims are not accorded Markush restriction practice because they do not meet the requirements to be accorded Markush practice under MPEE 803.02

**Groups 5-8.** Claims 3-5 are drawn to four inventions, each of which is a method of using a polypeptide, each of which is a distinct invention for the reasons set forth below, classified as Class 514, subclass 2+. It is noted for Applicant's convenience that this is a requirement for the election of a Group for

examination NOT a requirement for an election of species because although the claims are presented in Markush format, the claims are drawn to methods using multiple agents which do not share, as a whole, a substantial structural feature disclosed as being essential to their utility. Thus, the analysis of the claims, for restriction purposes, is subject to the findings of the court wherein the court found that unity of invention exists where entities included within a Markush group share a substantial structural feature disclosed as being essential to utility of the Markush group, *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Since the members of the group do not share a substantial structural feature disclosed as being essential to utility of the Markush group, the group as claimed fails the Harnisch test and the claims are not accorded Markush restriction practice because they do not meet the requirements to be accorded Markush practice under MPEE 803.02

**Groups 9-13.** Claim 6 is drawn to five inventions, each of which is an antibody that binds to a different polypeptide, each of which is a distinct invention for the reasons set forth below, classified as Class 530, subclass 386+. It is noted for Applicant's convenience that this is a requirement for the election of a Group for examination NOT a requirement for an election of species because although the claims are presented in Markush format, the claims are drawn to methods using multiple agents which do not share, as a whole, a substantial structural feature disclosed as being essential to their utility. Thus, the analysis of the claims, for restriction purposes, is subject to the findings of the court wherein the court found that unity of invention exists where entities included within a Markush group share a substantial structural feature disclosed as being essential to utility of the Markush group, *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte*

Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Since the members of the group do not share a substantial structural feature disclosed as being essential to utility of the Markush group, the group as claimed fails the Harnisch test and the claims are not accorded Markush restriction practice because they do not meet the requirements to be accorded Markush practice under MPEE 803.02

**Groups 14-18.** Claims 7-8 are drawn to five inventions, each of which is a method of using an antibody that binds to a different polypeptide, each of which is a distinct invention for the reasons set forth below, classified as Class 530, subclass 386+. It is noted for Applicant's convenience that this is a requirement for the election of a Group for examination NOT a requirement for an election of species because although the claims are presented in Markush format, the claims are drawn to methods using multiple agents which do not share, as a whole, a substantial structural feature disclosed as being essential to their utility. Thus, the analysis of the claims, for restriction purposes, is subject to the findings of the court wherein the court found that unity of invention exists where entities included within a Markush group share a substantial structural feature disclosed as being essential to utility of the Markush group, *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Since the members of the group do not share a substantial structural feature disclosed as being essential to utility of the Markush group, the group as claimed fails the Harnisch test and the claims are not accorded Markush restriction practice because they do not meet the requirements to be accorded Markush practice under MPEE 803.02

3. The inventions are distinct, each from the other because of the following reasons:

Inventions 1-4 and 9-13 as disclosed are biologically and chemically distinct, unrelated in structure and function, made by and used in different methods and are therefore distinct inventions.

The inventions of Groups 1-4 and 9-13 are materially distinct products having different structural formulas. For example, the inventions of Groups 1-4 are drawn to polypeptides each of which has a different structure and function, one from the other, which are different from the antibodies of Groups 9-13, each of which has a different structure and function, one from the other. Furthermore, each group encompasses numerous sequences. For example a search of a polypeptide having seven amino acids of any of the polypeptides would require a search that is different from a search of a polypeptide having complete identity to said polypeptides. Further, search for antibody that binds to the C terminal of any of the polypeptides claimed would require a search that is different from a search for an antibody to the N terminal of any of the polypeptides. Because the groups comprise numerous sequences, searching of any of groups 1-4 and 9-13 together would invoke a serious search burden.

Inventions 5-8 and 14-18 are materially distinct methods which differ at least in objectives, method steps and reagents. Each of the Groups is drawn to different objectives wherein the methods of Groups 5-8 are drawn to stimulating neutrophil cell chemotactic migration and the methods of Groups 14-18 are drawn to methods of inhibiting neutrophil cell chemotactic migration. Further, each of the groups uses different reagents to accomplish the methods, and therefore uses different dosages and schedules as well as response variables and criteria for success. Searching all of the groups with all of the different objectives, reagents,

dosages, schedules, response variables and criteria for success would invoke a high burden search.

The inventions of Groups 1-4 and 5-8, 14-18 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (i) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP*, 806.05(h)]. In the instant case the polypeptide products as claimed can be used in a materially different process such as production of antibodies against the polypeptides.

The inventions of Groups 9-13 and 14-18 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (i) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP*, 806.05(h)]. In the instant case the antibody products as claimed can be used in a materially different process such as production of anti-idiotypic antibodies against the claimed antibodies.

The inventions of Groups 9-13 and 4-8 are unrelated because the inventions of Groups 9-13 are not used in any of the methods of Groups 9-13.

The inventions of Groups 5 and 3/7 are not at all related because the invention of Groups 3/7 are not used in any of the methods of Group 5.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or

recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend**



**from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone

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number is (571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at 571-272-0787. The fax phone number for this Art Unit is (571) 273-8300.

A handwritten signature in black ink, appearing to read 'Susan Ungar', with a stylized flourish at the end.

Susan Ungar, PhD  
Primary Patent Examiner  
September 5, 2006